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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,786	11/10/2005	Martin Richardson	03164.0184USWO	3626
23552 7590 03/18/2008 MERCHANT & GOULD PC P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			EXAMINER LEWIS, KIM M	
			ART UNIT 3772	PAPER NUMBER
			MAIL DATE 03/18/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/534,786	Applicant(s) RICHARDSON, MARTIN	
	Examiner Kim M. Lewis	Art Unit 3772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 14-18 and 21 is/are rejected.
- 7) ☒ Claim(s) 8-13, 19 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>Detailed Action</u> . |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/21/08 has been entered.
2. As requested in the submission, claims 1, 7 and 18 have been amended and claim 21 has been added. Claims 1-21 are pending in the instant application.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 18 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. More specifically, the phrase "inguinal and groin" lacks support in the original specification and is therefore considered new matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 1 is rejected under 35 U.S.C. 102(b) as being Tanaka by U.S. Patent No. 5, 928,175 (“Tanaka”).

As regards claim 1, Tanaka discloses a medical corset that covers the pelvic region of a user and which anticipates applicant’s claimed invention. More specifically, Tanaka discloses a device (3) for bracing the pelvic region of a patient, the device comprising: a) a plurality of continuous straps (31-33) that are arranged and configured to be wrapped completely around the pelvic region of a patient, the straps being arranged in a side-by-side relationship (Fig. 1) and interconnected to each adjacent strap at one or more points (via 322) to restrict relative movement of the straps at the one or more points of interconnection, the plurality of straps include an upper strap and a lower strap, wherein when the device is positioned on the patient, the upper strap covers at least a first part of a region, where the first region includes an upper pelvic region and an adjoining the lower abdominal region of the patient and the lower strap covers and encircles at least part of a second region, where the second region includes a lower pelvic region and an adjoining crotch region of the patient; and fastening means (311, 312, 323, 333, 334) for holding the straps wrapped around the pelvic region of the patient, wherein when the device is positioned on the patient, the fastening means of

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the upper strap is releasable to provide access to at least part of the first region of the patient, and the fastening means of the lower strap is releasable to provide access to at least part of the second region of the patient.

Re. claim 21, the examiner contends that the area covered by the lower strap includes the crotch region which consists of the inguinal and groin region.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka.

As regards claims 2-3, the number of straps on the Tanaka device differs from the claimed number of straps. However, the examiner contends that it would have been

obvious to one having ordinary skill in the art to add additional straps on the device of Tanaka in order to provided wider coverage of device on the user.

Furthermore, Applicant should also note that it has been held that the duplicating the components of a prior art device is a design within the skill of the art. *In re Harza*, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

As regards claims 4-5, Tanaka does not disclose the recited dimensions or dimensional range of the straps. However, it has been held that a change in size of a prior art device is a design consideration within the skill of the art. *In re Rose*, 220 F.2d 459, 105 USPQ 237 (CCPA 1955).

As regards claims 6-7, Tanaka discloses that the connecting material that in use is wrapped around the pelvic region, (322) is constructed from cloth (col. 3, lines 56-59). Tanaka fails to teach the material is resiliently flexible. However, it has been held that the selection of a known material based upon its suitability for the intended use is a design consideration within the skill of the art. *In re Leshin*, 227 F. 2d, 125 USPQ 416 (CCPA 1960). Thus, it would have been obvious to one having ordinary skill in the art to provide a resiliently flexible cloth for the cloth of Tanaka since the straps are resiliently flexible. This will allow the straps to move with one another, thereby creating a more comfortable and conforming device.

10. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka in view of U.S. Patent No. 4,580, 555 ("Coppess").

As regard claim 14, Tanaka fails to disclose the adjustable strap features as presently claimed. Coppess, however, discloses a pelvic support splint having straps

with fastening means wherein the fastening means enable the length of each strap wrapped around the patient to be adjusted, thereby allowing the device to be fitted to patients of varying sizes and allowing pressure applied by each strap to the patient to be adjusted (note col. 3, lines 6-9, which discloses length adjustment). It would have been obvious to one having ordinary skill in the art to substitute the straps of Tanaka for the straps of Coppess because Coppess teaches straps having fastening means that enable the length of each strap wrapped around the patient to be adjusted, thereby allowing the device to be fitted to patients of varying sizes and allowing pressure applied by each strap to the patient to be adjusted.

As regards claims 15-17, both Tanaka and Coppess fail to disclose the device according to claim 1, wherein on each strap the fastening means includes a first attachment means and a plurality of co-operating second attachment means spaced along the length of the strap which can be coupled together so that each strap can form a loop of varying sizes, the device according to claim 14, wherein the first attachment means is in the form of a flexible tab and that the second attachment means is in the form of one or more openings through which the tab can be threaded and fastened, and the device according to claim 15, wherein each tab includes sections of hook and loop fasteners and that the openings are rings projecting from the straps, whereby in use, the tab can be threaded through a ring and folded on itself so that the hook and loop fasteners engage. Instead, Coppess discloses straps with adjustable male and female attachment components. These attachment components are capable of being moved along the length of the strap in order to adjust the loop formed by the strap in order to

form a loop of varying sizes. Since, the fastening means are equivalent because they perform the same function, it would have been obvious to one having ordinary skill in the art to substitute any equivalent fastening means such as hook and loop material that performs the function of securing the straps about a user and adjusts the loop size. Furthermore, the limitations of claim 16 and 17 would also have been obvious to one having ordinary skill in the art since they follow from use of hook and loop attachments.

Allowable Subject Matter

11. Claims 8-13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
12. Claim 18 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.
13. Claims 19-20 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

14. Applicant's arguments filed 1/21/08 have been fully considered but they are not persuasive. More specifically, applicant argues that Tanaka fails to disclose a lower strap that covers and encircles at least part of a region including a lower pelvic region and an adjoining crutch region of a patient, as recited in Applicant's claim 1. The

examiner contends that during use, the device of Tanaka is **capable** of covering and encircling a lower pelvic region and or adjoining crutch region of a patient. Applicant should note that the argument is based on either functional language and/or an intended use recitation, which the examiner contends does not patentably distinguish applicant's invention over the prior art since it is capable of functioning in like manner.

With respect to claims 2-7, applicant argues that since claim 1 is allowable and claims 2-7 depend from claim 1, they too are allowable. It also appears that applicant argues that the device of Tanaka is concerned with the treatment of lame hips or preventing sciatic nerve irritation so as to correct posture, and the modification of the device of Tanaka to include the deficiencies outlined by the examiner in the rejection of claims 2-7 is not obvious since there is no teaching and/or suggestion to modify the device in the manner recited in claims 2-7.

With respect to claims 2-3, the examiner contends that modifying Tanaka to include additional straps, in view of *In re Harza* (note citation above) would have been obvious to one having ordinary skill in the art, in order to provide wider coverage of the device on a user, particularly, when the device is to be used on a patient having a height/length greater than the general population.

With respect to claims 4-5, the examiner contends that modifying Tanaka to include the claimed dimensions or dimensional range, in view of *In re Rose* (note citation above) would have been an obvious design consideration to one having ordinary skill in the art since one having ordinary skill in the art would be concerned with adjusting the size of the device of Tanaka to fit different sized patients.

With respect to claims 6-7, as note in the rejection above, it would have been obvious to one having ordinary skill in the art to provide resiliently flexible connecting material in order to allow the straps to move with one another, thereby creating a more comfortable and conforming device.

With respect to claims 14-17, Applicant argues that claims 14-17 depend from claim 1 and that neither Tanaka nor Coppess discloses the invention recited in claim 1. The examiner disagrees with Applicant. As discussed above in the rejection of claim 1, and further discussed in the response to the arguments, Tanaka discloses applicant's claimed invention.

Conclusion

15. This is a continuation of applicant's earlier Application No. 10534786. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kim M. Lewis whose telephone number is (571) 272-4796. The examiner can normally be reached on Wednesday to Friday, from 5:30 am to 4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patricia Bianco, can be reached on (571) 272-4940. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kim M. Lewis/
Primary Examiner
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kml

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